

REMARKS

Applicant's attorney thanks the Examiner, the Primary Examiner, and the Supervisory Patent Examiner for their participation in telephone conferences elaborating on the present Office Action. Based on the telephone conferences, Applicant believes that Supervisory Patent Examiner Lefkowitz acknowledged that Applicant is entitled to be his own lexicographer with respect to the term "hydraulic structure" in so far as Applicant's definition was not contrary to the understanding in the art of that term. The present Office Action does not state or even hint that Applicant's usage is contrary to the ordinary meaning of the term "hydraulic structure."

Furthermore, this reasoning is belied by the fact that (1) the Applicant pointed to specific support for the term in the specification as filed and (2) the Office Action cites no definition of the term "hydraulic structure" that is contrary to Applicant's usage. Applicant requests that a subsequent non-final Office Action (1) provide an accurate explanation for the rejection in writing and (2) cite supporting authority if the rejection is maintained.

This communication responds to the reason cited in the written Office Action, *i.e.* that a "hydraulic structure" is not supported by the specification as filed, as well as the rationale raised by telephone conference that the meaning of the term "hydraulic structure" as used by the Applicant is contrary to the understanding of that term in the art.

**The Claimed "Hydraulic Structures" Are Supported
By Specific Citation To The Written Description**

The December 16, 2002 Final Office Action raises only a rejection under 35 USC 112, paragraph 1. The Examiner appears to raise a written description rejection by explaining that "a hydraulic structure ... is not disclosed in the specification." The Examiner is applying an

improper in haec verba test, *i.e.* the words “hydraulic structure” must have been present in the application as filed to support the amendment.

Applicant respectfully traverses the rejection as the invention as claimed is fully described in the specification. In effect, no consideration appears to be given to the Applicant’s October 25, 2002 Response wherein a “hydraulic structure” was defined as an artificial hydraulic structure, *e.g.*, bridges, piers, abutments, levees, dams and culverts (described in the specification), in a hydrologic feature, *e.g.*, a body of water or a waterway (also described in the specification). Applicant further cited to specific support in the specification for a hydraulic structure. There can be no clearer basis for support in the written description than the specific pages and lines cited by Applicant.

As explained by the Federal Circuit, the specification “need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed.” Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 U.S.P.Q.2d 1467, 1470 (Fed. Cir. 1995) (citations omitted). In a case applying that rationale with facts similar to those here, the Federal Circuit held that a claim to an “original unidentified mass” was valid under the written description requirement even though that term did not appear in the specification as filed. All Dental Prodx, LLC v. Advantage Dental Prods., 309 F.3d 774 (Fed. Cir. 2002). Thus, the test is what one would have understood was invented, not what words literally appeared.

There can be no doubt that that hydraulic structures, *e.g.* bridges, piers, levees, abutments, dams and culverts, were described in the specification. See the specification, page 14, lines 12-13. Clearly, one would have understood that these structures were supported by the written description. Thus, the claims are supported by the written description. Based on

Applicant's attorney's telephone conferences with the Office, it is believed that this basis for the rejection is or will be withdrawn.

Applicant Uses "Hydraulic Structure" Consistent With Its Meaning In The Relevant Art

The present Office Action does not explain that Applicant is using a term contrary to its ordinary meaning. In fact, no authority or contrary definition is even offered. Nonetheless, in order to expedite prosecution, Applicant cites references that show use of the term "hydraulic structure" consistent with Applicant's use. See e.g. U.S. Patent No. 4,832,528, col. 3, lines 57-59 ("FIG. 1 ... shows a partial cross-section of a hydraulic structure ... such as for example a dam or a dyke for retaining water."); U.S. Patent No. 5,720,576, col. 1, lines 8-9 ("hydraulic structures, such as dams, canals, reservoirs, tunnels"); U.S. Patent No. 4,498,808, col. 1, lines 53-54 ("man-made hydraulic structures such as bridge piers, wharfs, or river training works...."); U.S. Patent No. 5,349,327, col. 2, lines 4-10 ("Any said structure of the ... invention may be termed a 'hydraulic structure', the word 'hydraulic' being used to mean any suitable structure in and or on said bed underlying water. A said structure may be artificial (e.g. at least partly man and/or machine made), for instance a bridge, dam, lock, wall, or weir."); *Highway Drainage Guidelines [Metric Edition]*, American Association of State Highway and Transportation Officials, 1999 (glossary defining abutment, bridge, and hydraulic structure -- "A facility used for such things as to impound, accommodate, convey, or control the flow of water, such as a dam, weir, intake, culvert, channel or bridge.") (Copies of these references are enclosed with the accompanying Information Disclosure Statement).

Clearly, in view of the specification as a whole, a full and complete understanding of the invention by one of ordinary skill in the art, the written description of the specification as filed

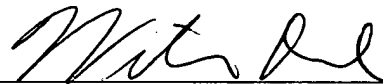
supports the claims directed to a "hydraulic structure" and that the term "hydraulic structure" is used in a manner consistent with its ordinary meaning.

CONCLUSION

Based on the above Remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with Applicant's attorney would be helpful in expediting the prosecution of this application, the Examiner is invited to call the undersigned at (617) 832-1288.

Respectfully submitted,

FOLEY HOAG LLP



William D. DeVaul

Reg. No. 42,483

Attorney for Applicant

Date: March 17, 2003

Patent Group
Foley Hoag LLP
155 Seaport Blvd.
Boston, MA 02210-2600